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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Kristen McRedmond

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MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

EXAMINER

NGUYEN, NGA B

ART UNIT

PAPER NUMBER

3692

MAIL DATE

DELIVERY MODE

05/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/783,499	Applicant(s) MCREDMOND, KRISTEN	
	Examiner Nga B. Nguyen	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is the answer to the communication filed on January 21, 2008, which paper has been placed of record in the file.
2. Claims 1-32 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1-32 have been fully considered but are not persuasive.

In response to the applicant's arguments that Shkedy fails to teach "creating a secondary market for private equity", examiner submits that Shkedy discloses a computer system facilitating a transaction of registered securities of an investment company on a secondary market wherein the investment company is preferably a mutual fund or a hedge fund. Thus, Shkedy discloses "creating a secondary market for a mutual fund or a hedge fund." However, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP, 2106.

For the reason set forth above, examiner decides to maintain the previous rejection (also see details below) and make this Office action FINAL.

4. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 5-18, 20-26, and 28-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Shkedy, U.S. Patent No. 6,236,972.

Regarding to claim 1, Shkedy discloses a method for creating a secondary market for private equity, comprising:

registering accredited investors with a system operator (*column 9, lines 48-55 and figure 2; registering customers with the central controller 200, the customer information stored in customer database 255*);

registering securities based on private equity with said system operator, said securities being qualified by said system operator (*column 9, lines 57-63 and figure 2; registering mutual fund with the central controller, the mutual fund information stored in Mutual Fund database 260*); and

said system operator auctioning said securities to said accredited investors over an electronic network (*column 12, lines 25-40; the central controller auctioning mutual funds to buyers and sellers*).

Regarding to claim 2, Shkedy discloses wherein said auctioning is conducted over the Internet (*column 12, lines 47-53*).

Regarding to claim 3, Shkedy discloses wherein said private equity is selected from the group consisting of limited partnership interests and private equity in individual companies (*column 5, lines 50-57; mutual fund is a private equity in individual companies*).

Regarding to claim 5, Shkedy discloses auctioning is initiated by a seller offering said securities for sale (*column 12, lines 30-35*).

Regarding to claim 6, Shkedy discloses wherein said auctioning is initiated by said accredited investor putting out a bid to purchase said security (*column 12, lines 27-30*).

Regarding to claim 7, Shkedy discloses wherein said bid is for a private asset of a type that matches said security (*column 12, lines 35-40*).

Regarding to claims 8-9, Shkedy discloses charging said seller an accredited investor a transaction fee (*column 6, lines 15-23*).

Regarding to claim 10, Shkedy discloses creating puts and calls based on said securities (*column 6, lines 15-58; creating buy order or sell order from buyer or seller*).

Regarding to claims 11-12, Shkedy discloses notifying accredited investors by e-mail of a seller offering said securities for sale; notifying sellers by e-mail of an accredited investors bid for a private asset of a type that matches said security (*column 7, lines 4-10 and column 12, lines 34-38*).

Regarding to claim 13, Shkedy discloses wherein said securities that are qualified by said system operator are venture-backed securities (*column 5, lines 50-57; mutual funds or hedge funds*).

Regarding to claim 14, Shkedy discloses collecting securities preferences from said accredited investors; and notifying said accredited investors when securities matching the preferences are being auctioned (*column 12, lines 25-40; central controller collects buy orders and matches buy order with sell orders*).

Regarding to claim 15, Shkedy discloses registering sellers of securities with said system operator; collecting securities-related information from said sellers; and notifying

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said sellers when bids from accredited investors are received to purchase securities matching sellers' type of securities (*column 12, lines 25-40; central controller collects sell orders and matches sell orders with buy orders*).

Regarding to claim 16, Shkedy discloses a system for creating a secondary market for private equity, comprising: a system operator server facility connected to an electronic network, said server facility: database storage means; instructions for performing the method as described in claim 1 above (*figures 1-2, central controller 200*).

Claims 17, 18, and 20-25 have similar limitations found in claims 2, 3, 5, 11-15, respectively above, therefore, are rejected by the same rationale.

Claims 26 and 28-30 have similar limitations found in claims 1, 2, 8, 9, 6, 14, respectively above, therefore, are rejected by the same rationale. Note that mutual funds or hedge funds are equivalent to restricted public securities.

Regarding to claims 31-32, Shkedy discloses providing an inventory of said securities by having the system operator take a position in certain restricted public securities and in private equities (*column 14, lines 25-45; central controller check the sufficiency of shares in seller account*).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious

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at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 19, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shkedy, U.S. Patent No. 6,236,972, in view of Hambrecht et al (hereinafter Hambrecht), U.S. Patent No. 6,629,082.

Regarding to claims 4, 19, 27, Shkedy does not disclose creating and storing audio-visual information and a business plan for said private equity; and allowing accredited investors access, over the Internet, to said audio-visual information and business plan for said private equity upon which said auctioned securities are based. However, Hambrecht discloses creating and storing audio-visual information and a business plan for said private equity; and allowing accredited investors access, over the Internet, to said audio-visual information and business plan for said private equity upon which said auctioned securities are based (*column 9, lines 35-41 and column 10, line 60*). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Shkedy's to include the feature above for the purpose of providing securities information in video and audio format in order to attract the customers to invest in the securities.

Conclusion

9. Claims **1-32** are rejected.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is

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(571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-6796 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nga B. Nguyen/

Primary Examiner, Art Unit 3692

May 5, 2009